

PATENT**Serial No. 10/824,533****Attorney Docket No. 1059-003****REMARKS**

Reconsideration of this application is respectfully requested in light of the foregoing amendments and the following remarks.

Each of claims 1, 13, and 14 has been amended for reasons unrelated to patentability, including at least one of: to explicitly present one or more elements implicit in the claim as originally written when viewed in light of the specification thereby not narrowing the scope of the claim, to detect infringement more easily, to enlarge the scope of infringement, to cover different kinds of infringement (direct, indirect, contributory, induced, and/or importation, etc.), to expedite the issuance of a claim of particular current licensing interest, to target the claim to a party currently interested in licensing certain embodiments, to enlarge the royalty base of the claim, to cover a particular product or person in the marketplace, and/or to target the claim to a particular industry.

Claims 1-21 are now pending in this application. Claims 1, 13, and 14 are the independent claims.

I. The Enablement Rejection

Claim 15 was rejected under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the enablement requirement. This rejection is respectfully traversed.

The rejection states that “[i]n claim 15, Applicant sets forth the method as including the step of ‘assembling the headrest assembly’” and “[t]his steps [sic] appear after the steps of attaching the headrest to the uprights, and adjusting the headrest assembly.” The rejection also states that “the claimed sequence of steps also appears to contradict Figure 7.” This rejection language suggests a potential misunderstanding regarding the proper interpretation of method claims and suggests the root of the improper enablement rejection.

“The problem is to interpret claims ‘in view of the specification’ without unnecessarily importing limitations from the specification into the claims”, *Altiris Inc. v. Symantec Corp.*, 318

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F.3d 1363, 1371, 65 USPQ2d 1865, 1869-70 (Fed. Cir. 2003) (although the specification discussed only a single embodiment, the court held that it was **improper to read a specific order of steps into method claims** where, as a matter of logic or grammar, the language of the method claims did not impose a specific order on the performance of the method steps, and the specification did not directly or implicitly require a particular order). *See also* MPEP 2111.01

Claim 15 requires no specific order on the performance of its "steps". Therefore, there is no contradiction between claim 15 and Figure 7. Consequently, claim 15 is properly enabled..

Thus, reconsideration and withdrawal of this rejection is respectfully requested.

II. The Anticipation Rejection

Claims 1 and 2 were rejected as anticipated under 35 U.S.C. §102(b). In support of the rejection, Sims (U.S. Patent No. 5,791,614) was cited. This rejection is respectfully traversed.

Sims fails to establish a prima facie case of anticipation. *See* MPEP 2131. To anticipate expressly, the "invention must have been known to the art in the detail of the claim; that is, all of the elements and limitations of the claim must be shown in a single prior art reference, arranged as in the claim". *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1383, 58 USPQ2d 1286, 1291 (Fed. Cir. 2001). The single reference must describe the claimed subject matter "with sufficient clarity and detail to establish that the subject matter existed in the prior art and that its existence was recognized by persons of ordinary skill in the field of the invention". *Crown Operations Int'l, LTD v. Solutia Inc.*, 289 F.3d 1367, 1375, 62 USPQ2d 1917, 1921 (Fed. Cir. 2002). Moreover, the prior art reference must be sufficient to enable one with ordinary skill in the art to practice the claimed invention. *In re Borst*, 345 F.2d 851, 855, 145 USPQ 554, 557 (C.C.P.A. 1965), *cert. denied*, 382 U.S. 973 (1966); *Amgen, Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1354, 65 USPQ2d 1385, 1416 (Fed. Cir. 2003) ("A claimed invention cannot be anticipated by a prior art reference if the allegedly anticipatory disclosures cited as prior art are not enabled.")

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Claim 1 recites “a **headrest** assembly adapted to non-destructively snapably attach to a pair of **uprights** of a **wheelchair**, said headrest assembly comprising a substantially rigid horizontal member adapted to substantially span a width defined by the pair of uprights”.

As explained at MPEP 2111.01, the words of a claim must be given their plain meaning unless they are defined in the specification. Here, the claim terms “headrest”, “upright”, and “wheelchair” clearly have been defined in the specification at paragraphs 13, 11, and 10, respectively, and those definitions must control examination of those claims that recite these terms.

Interpreting claim 1 in light of the explicit definitions for its terms, Sims does not teach expressly or inherently “a **headrest** assembly adapted to non-destructively snapably attach to a pair of **uprights** of a **wheelchair**, said headrest assembly comprising a substantially rigid horizontal member adapted to substantially span a width defined by the pair of uprights”.

For example, Sims provides no teaching that its “headrest 21” is “adapted to non-destructively snapably attached to” its “head rest posts 17 and 18”. See col. 3, line 65 through col. 4, line 4.

In fact, Sims does not even teach a “wheelchair”. Instead, Sims allegedly states that “the present invention relates to an accessory for use with seats having headrests mounted thereon via one or more head rest posts. Such seats have various applications and may be found in various modes of transportation such as automobiles, trains, buses, and aircraft, and elsewhere.” See col. 1, lines 5-10.

Accordingly, it is respectfully submitted that the rejection of claim 1 is unsupported by Sims and should be withdrawn. Also, the rejection of claim 2, which depends from independent claim 1, is unsupported by Sims and also should be withdrawn.

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III. The Obviousness Rejection

Claims 1-7, 11, and 12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over various combinations of Lane (U.S. Patent No. 3730589), Sims (U.S. Patent No. 5791614), Benoit (US Patent No. 6099021), Higley et al (U.S. Patent No. 2004/0104614) and/or MacDonald (U.S. Patent No. 4375901). These rejections are respectfully traversed.

None of the cited references, either alone or in any combination, establish a *prima facie* case of obviousness. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure." See MPEP 2143.

To the extent that official notice is taken to support the rejection, Applicants respectfully traverse and request citation and provision of a reference that supports the rejection. See MPEP 2144.03.

Independent claim 1 recites a "headrest assembly comprising a substantially rigid horizontal member adapted to substantially span a width defined by the pair of uprights and to substantially span above handles of the wheelchair". Independent claims 13 and 14 recite a "headrest assembly comprising a substantially rigid horizontal member" "substantially spanning a width defined by" a "pair of uprights" and "substantially spanning above handles of the wheelchair".

None of the cited references expressly or inherently teach or suggest a "headrest assembly comprising a substantially rigid horizontal member" "adapted to substantially span a width

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defined by the pair of uprights **and** to substantially span **above** handles of the wheelchair”, or “substantially spanning a width defined by” a “pair of uprights” and “substantially spanning **above** handles of the wheelchair”.

Thus, even if there were motivation or suggestion to modify or combine the cited references (an assumption with which the applicant disagrees and for which no evidence has been properly presented), and even if there were a reasonable expectation of success in combining or modify the cited references (another assumption with which the applicant disagrees and for which no evidence has been properly presented), the cited references still do not expressly or inherently teach or suggest **every** limitation of the independent claims, and consequently fail to establish a *prima facie* case of obviousness.

Because no *prima facie* rejection of any independent claim has been presented, no *prima facie* rejection of any dependent claim can be properly asserted. Consequently, reconsideration and withdrawal of these rejections is respectfully requested.

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CONCLUSION

It is respectfully submitted that, in view of the foregoing amendments and remarks, the application as amended is in clear condition for allowance. Reconsideration, withdrawal of all grounds of rejection, and issuance of a Notice of Allowance are earnestly solicited.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. §1.16 or §1.17 to Deposit Account No. 50-2504. The Examiner is invited to contact the undersigned at 434-972-9988 to discuss any matter regarding this application.

Respectfully submitted,

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